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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,802	05/22/2001	Jenny Valladeau	SF0695B	3523

24265 7590 05/16/2003

SCHERING-PLOUGH CORPORATION  
PATENT DEPARTMENT (K-6-1, 1990)  
2000 GALLOPING HILL ROAD  
KENILWORTH, NJ 07033-0530

EXAMINER

SWARTZ, RODNEY P

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 05/16/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/862,802

Applicant(s)

VALLADEAU ET AL.

Examiner

Rodney P. Swartz, Ph.D.

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Pri rity under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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## **DETAILED ACTION**

### **Election/Restriction**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3, drawn to polypeptide SEQ ID NO:2, classified in class 530, subclass 350.
  - II. Claims 1-3, drawn to polypeptide SEQ ID NO:4, classified in class 530, subclass 350.
  - III. Claims 1-3, drawn to polypeptide SEQ ID NO:8, classified in class 530, subclass 350.
  - IV. Claims 1-3, drawn to polypeptide SEQ ID NO:10, classified in class 530, subclass 350.
  - V. Claims 4 and 5, drawn to compound which specifically binds to SEQ ID NO:2, classified in class 424, subclass 130.1.
  - VI. Claims 4 and 5, drawn to compound which specifically binds to SEQ ID NO:4, classified in class 424, subclass 130.1.
  - VII. Claims 4 and 5, drawn to compound which specifically binds to SEQ ID NO:8, classified in class 424, subclass 130.1.
  - VIII. Claims 4 and 5, drawn to compound which specifically binds to SEQ ID NO:10, classified in class 424, subclass 130.1.

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- IX. Claims 6-9, drawn to DNA, vector, hosts cells which encode SEQ ID NO:2, classified in class 435, subclass 69.1.
- X. Claims 6-9, drawn to DNA, vector, hosts cells which encode SEQ ID NO:4, classified in class 435, subclass 69.1.
- XI. Claims 6-9, drawn to DNA, vector, hosts cells which encode SEQ ID NO:8, classified in class 435, subclass 69.1.
- XII. Claims 6-9, drawn to DNA, vector, hosts cells which encode SEQ ID NO:10, classified in class 435, subclass 69.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-IV are drawn to patentably distinct polypeptides as evidenced by their distinct sequences.

Inventions V-VIII are drawn to patentably distinct binding compounds because each binding compound binds to a different amino acid sequence.

Inventions IX-XII are drawn to patentably distinct nucleic acids which encode patentably distinct polypeptides.

Inventions I-IV and V-VIII are drawn to patentably distinct molecules. Inventions I-IV are drawn to polypeptides while Inventions V-VIII are drawn to compounds which bind polypeptides.

Inventions I-IV and IX-XII are drawn to patentably distinct molecules. Inventions I-IV are drawn to polypeptides while Inventions IX-XII are drawn to nucleic acids.

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Inventions V-VIII and IX-XII are drawn to patentably distinct molecules. Inventions V-VIII are drawn to compounds which bind polypeptides while Inventions IX-XII are drawn to nucleic acids.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and because while the searches may overlap, the searches are not coextensive, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

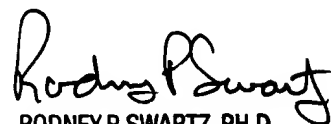
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney P. Swartz, Ph.D., whose telephone number is (703) 308-4244. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM EST.

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If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith, can be reached on (703)308-3909. The facsimile telephone number for the Art Unit Group is (703)308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.



RODNEY P SWARTZ, PH.D  
PRIMARY EXAMINER

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May 14, 2003